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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL F. GUHEEN,
JAMES D. MITCHELL, and
JAMES J. BARRESE

Appeal 2008-003193
Application 09/321,360
Technology Center 3600

Decided: March 10, 2010

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael F. Guheen et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.[1]

THE INVENTION

This invention is:

> A system, method, and article of manufacture are provided for displaying phases of delivery of components of a system by first displaying a pictorial representation of an existing system including a plurality of components. Next, a first set of components are presented that are to be delivered in a first phase. This is accomplished by indicia coding the first set of components in a specific manner. Further, a second set of components are presented that are to be delivered in a second phase. This is carried out by indicia coding the second set of components in a manner unique with respect to the indicia coding of the first set of components.

Specification 3: Abstract.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jun. 6, 2007) and Reply Brief ("Reply Br.," filed Nov. 21, 2007), and the Examiner's Answer ("Answer," mailed Sep. 21, 2007).

1. A method for displaying phases on a computer system in which components of a system for providing a web architecture framework are delivered, wherein all steps are performed on the computer, the method comprising the steps of:

(a) displaying, through a display adapter by a processor, a pictorial representation of an existing system including a plurality of components;

(b) identifying, from the plurality of components, a first component group containing additional components and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system;

(c) compiling, by the processor, an ordered listing of the additional components for implementation into the existing system, the ordered listing providing an order that is required for installing the components in the web architecture framework;

(d) determining, by the processor, a first set of the additional components for implementation in a first implementation phase;

(e) determining, by the processor, a second set of the additional components for implementation in a second implementation phase, the first set being implemented before the second set can be implemented;

(f) modifying, through the display adapter by the processor, the pictorial representation of the existing system to show a pictorial representation of the first set of components being indicia coded to indicate that they are to be delivered in the first phase; and

(g) modifying, through the display adapter by the processor, the pictorial representation of the existing system to show a pictorial representation of the second set of components being indicia coded in a manner unique with respect to the indicia coding of the first set of components to indicate that the second set of components is to be delivered in the second phase and that a proper functioning of the second set of components require an installation of the first set of components in the first phase.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Rassman	US 4,937,743	Jun. 26, 1990
Turnbull	US 5,208,765	May 4, 1993

The following rejection is before us for review:

1. Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rassman and Turnbull.

ARGUMENTS

In the Appeal Brief, each independent claim is grouped separately. However, the Appellants provide the same two arguments for each group. App. Br. 35-38. The Appellants argue that that the combination of Rassman and Turnbull do not suggest the claimed steps of 1) identifying a first and second component group and 2) compiling an ordered listing. App. Br. 35-38 and Reply Br. 2-6. The Appellant does not provide separate arguments for the dependent claims, except for claim 19.

Turning to the Appellants' first argument, in the rejection, the Examiner identifies the primary and secondary resources of Rassman as the components. Answer 3-4. The Examiner seems to consider the secondary resources that are displayed in the cell as the first component group of additional required components. Answer 3-4. *See* FF 1. The Examiner then specifies that the "additional options" in column 8, lines 20-36 of Rassman represents the claimed second component group of optional components. Answer 4. The Examiner states, "[a]lso, specifically, in col. 8, lines 20-36, the implementation of an application where the display of secondary resources can be employed to make additional options available, which represent the optional components." Answer 4.

The Appellants first argue that secondary resources are necessary and not optional. App. Br. 27. The Appellants also argue that the Examiner has misinterpreted Rassman. The Appellants assert that "additional options" in Rassman is referring to an additional display function and not to optional secondary resources. App Br. 27 and Reply Br. 4-5.

The Examiner responds:

> These additional options represent the optional components. Appellant argues that these are merely optional display functions for displaying a representation of a second resource. However, Rassman specifically discloses that "secondary resources could also be employed to make additional options available" in lines 29-30, thus indicating that by displaying these secondary resources, that options are derived from the secondary resources, and that secondary resources can be used for additional options, thereby representing a second component group containing optional components.

Answer 12.

Turning to the Appellants' second argument, in the rejection, the Examiner cites Turnbull's product control matrix 100 to teach an ordered listing providing an order that is required for installing the components in the web architecture framework. Answer 7. The Appellants argues that the order of the requirements in the product matrix is not sequential or chronological. App. Br. 28-29 and Reply Br. 5-6. Therefore, the Appellants assert that that the order in Turnbull is not "required" as claimed. App. Br. 29. The Appellants state "[a]lthough Turnbull may disclose an ordered list of necessary requirements for completing a stage, the ordered list is not required for completing the stage." App. Br. 29.

The Examiner responds that the product matrix 100, while not showing a sequential or chronological order, does show an order that is required for the completion of each stage. Answer 12-13.

Further, in the Reply Brief, the Appellants argue that neither Rassman nor Turnbull are analogous art and, therefore, they cannot be relied upon. Reply Br. 3-4. The Appellants states that their invention is "directed to displaying phases in which components must be delivered for providing a web architecture." Reply Br. 3. The Appellants argue that Rassman is non-analogous because Rassman is directed to resolving resource conflict in surgical procedures. Reply Br. 3. The Appellants argue that Turnbull is non-analogous because Turnbull is direct to the manufacture of semiconductors. Reply Br. 3-4.

Finally, turning to Appellants' argument regarding claim 19, the Appellants argue that the combination of Rassman and Turnbull fails to teach "separating the remaining components into primary components and

secondary components, wherein the primary components must be installed before the secondary components can function properly." App. Br. 38-39 and Reply Br. 6-7. The Appellants argue that Rassman fails to teach separating the operating rooms into primary and secondary components and fails to teach prioritizing operating rooms. App. Br. 39.

The Examiner responds by pointing to column 11, lines 19-24 of Rassman to show prioritizing of components. Answer 13-14.

ISSUES

The issue is whether claims 1-19 are obvious under 35 U.S.C. §103(a) over Rassman and Turnbull. Specifically, the first major issue is whether Rassman teaches identifying a second component group containing optional components that are optional for the implementation of the system. The second major issue is whether the claims require that the ordered listing be in a sequential or chronological order.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification does not contain an express definition of "optional."

2. A definition of "optional" is "left to one's option: open to choice; not compulsory; elective" *See Webster's New World Dictionary of the American Language, College Edition* 1029 (1964) (Entry for "optional").

3. The Specification states "[t]he present invention relates to conveying information regarding a web architecture framework and more particularly to demonstrating phases of delivery of components of a system that are required for implementation of technology." Specification 1:16-18.

Rassman

4. Rassman states that "[t]he invention relates to a method for managing resources and particularly to the method and system for prospective scheduling and real time dynamic management of a plurality of interdependent and interrelated resources using a computer system for communicating information." Rassman Col. 1, ll. 8-13.

5. Rassman describes constructions of building as a field where the invention could be used. Rassman Col. 1, lines 16-25.

6. Rassman also describes monitoring and planning the use of the facilities and other resources in surgical suite of a hospital as an example. Rassman Col. 4, ll. 37-40.

7. Rassman describes resources as a room, a person, a piece of equipment, Rassman Col. 5, ll. 5-53. *See also* Rassman col. 1, ll. 31-36.

8. Rassman describes that a primary database includes information about know procedures and states:

For example, it may include information like: an appendectomy should be scheduled to take 90 minutes, requires that medications A, B, C and D be available, that only one operating rooms X, Y and Z are suitable for such a procedure and that only doctors J, K and L are authorized to perform such operations.

Rassman Col. 4, ll. 58-65.

9. Figure 8 of Rassman is reproduced below.

FIG. 8.

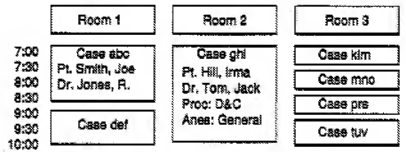

Figure 8 of Rassman depicts schedule for a surgical suite of a hospital. *See* Rassman Col.14: ll. 37-39 and col. 3: ll.44-45.

10. Column 5, lines 18-23 of Rassman states: "Each surgical operating room has a planned use in time and the intended use may be associated with a particular patient, pieces of equipment and procedure, as well as key personnel who will be involved in performing the operation and the medications to be administered."

11. Column 8, lines 15-20 of Rassman states: 'Space permitting, a cell could also be made to have several pieces of data relating to secondary resources displayed therein. For example, within the cell that represents "Case abc" the name of the surgeon or the type of equipment being employed could be displayed.'

Turnbull

12. Turnbull states "[t]his invention relates generally to computer tracking of manufacturing and in particular to a computer-based method for monitoring product development and/or manufacturing to assure profitable

manufacture of a functional, reliable, and quality product." Turnbull: Col. 1, ll. 7-11.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

> [W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

> Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

> person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-6 and 19 under §103(a) as being unpatentable over Rassman and Turnbull.

Turning to the Appellants' first argument, the Appellants argue that Rassman does not teach the step of identifying, from the plurality of components, a second component group containing optional components. Claim 1 recites "identifying, from the plurality of components, a first component group containing additional components and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system." We note that claim 1 does not recite any requirements as to how and when the components are identified.

We find that Rassman teaches identifying, from the plurality of components, a second group containing optional components. In Figure 8, Rassman provides a pictorial representation of a schedule for a hospital surgical suite (*i.e.* a system). FF 9. The schedule includes rooms 1-3 (FF 9), which can be considered some of the claimed components.

From these displayed room schedules, other secondary resources can be identified. Rassman describes that the intended use of the room is associated with other resources. *See* FF 10. For example, the schedule for room 1 in Figure 8 could show that the procedure for Case def is an appendectomy. *See* FF 11. Rassman also describes that the primary data base includes information about known procedures, including information about the resources for that procedure. FF 8. Rassman states,

> [f]or example, it may include information like: an appendectomy should be scheduled to take 90 minutes, requires that medications A, B, C and D be available, that only one operating rooms X, Y and Z are suitable for such a procedure and that only doctors J, K and L are authorized to perform such operations.

Rassman col. 4, ll. 60-65. The set of resources, such as medication, doctor, room, etc that are scheduled (*i.e.* identified) for the case can be considered the claimed additional components. They are required for the procedure to be performed. However, the database also identifies resources that are optional – such as doctors Y and Z when not chosen for the procedure. We note that the broadest reasonable meaning, which is consistent with the Specification, of "optional" is "left to one's option: open to choice; not compulsory; elective." FF 1-2. The choice of using Doctors Y and Z was "open for choice." This would similarly also be done for *Case abc* in room

1 and similarly more additional and optional components would be identified.

Therefore, we find that Rassman teaches the claimed step of identifying, from the plurality of components, a second component group, containing optional components.

Turning to the Appellants second argument, the Appellants argue that Turnbull does not teach "an order that is required for installing the components" as recited in claim 1. App. Br. 29 and Reply Br. 5-6. The Appellants seem to argue that this requires that Turnbull's requirements (*i.e.* components), in the product matrix, be listed in sequential or chronological order as to when they must be installed relative to other components. App. Br. 29 and Reply Br. 5-6.

We find no such requirement in claim 1. Claim 1 recites "the ordered listing providing an order that is required for installing the components in the web architecture framework." Claim 1 does not require that the order listing of components be sequentially or chronologically. Nor does it require that the order reflect which components have to be installed relative to other components. The Appellants' argument is directed to limitations not found in the claims.

Finally, we turn to the Appellants' argument that the both Rassman and Turnbull are non-analogous art. Reply Br. 3-4. Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir.

1992). *See also In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979).

The Appellant's Specification describes their field of endeavor as including "demonstrating phases of delivery of components of a system that are required for implementation of technology." FF 3. We find that this is the same as Rassman's field of endeavor. Rassman states that their invention relates to "prospective scheduling and real time dynamic management of a plurality of interdependent and interrelated resources using a computer system for communicating information." FF 4. We note that Rassman also includes an example of scheduling the construction of building along with scheduling the use of a surgical suite. FF 5-6. The Appellants' and Rassman's field of endeavor are the same – both relate to the creation of a depiction of a schedule for the use or creation of a product. We find that Rassman is analogous art.

Further, we find that the Appellants' and Turnbull's field of endeavor are the same. Turnbull invention relates "to a computer-based method for monitoring product development and/or manufacturing." FF 12. Turnbull also relates to the creation of a depiction of a schedule for the creation of a product. We find that Turnbull is analogous art.

Accordingly, we find that the Appellants have not overcome the prima facie showing of obviousness, and we sustain the rejection of claim 1, and claims 2-6, dependent thereon, under 35 U.S.C. §103(a) as unpatentable over Rassman and Turnbull.

The rejection of claims 7-12 under §103(a) as being unpatentable over Rassman and Turnbull.

Claim 7 recites a computer program embodied on a computer readable medium that comprises a code segment that performs the step at issue in claim 1 above. In traversing the rejection of claim 7, the Appellant again asserts the same argument as discussed above with regards to claim 1 (App. Br. 30-32), and the Examiner relies upon their response with regards to claim 1 (Answer 13). For the same reasons as provided for claim 1, we find that the Appellants have not overcome the prima facie showing of obviousness, and we sustain the rejection of claim 7, and claims 8-12, dependent thereon, under 35 U.S.C. §103(a) as unpatentable over Rassman and Turnbull.

The rejection of claims 13-18 under §103(a) as being unpatentable over Rassman and Turnbull.

Claim 13 recites an apparatus which includes logic for performing the step at issue in claim 1 above. Again, in traversing the rejection of claim 13, the Appellants again assert the same argument as discussed above with regards to claim 1 (App. Br. 34-36), and the Examiner relies upon their response with regards to claim 1 (Answer 13). For the same reasons as provided for claim 1, we find that the Appellants have not overcome the prima facie showing of obviousness, and we sustain the rejection of claim 13, and claims 17-18, dependent thereon, under 35 U.S.C. §103(a) as unpatentable over Rassman and Turnbull.

The rejection of claim 19 under §103(a) as being unpatentable over Rassman and Turnbull.

Claim 19 recites "separating the remaining components into primary components and secondary components, wherein the primary components must be installed before the secondary components can function properly." *See* Claim 19(i). We find that Rassman teaches this claimed limitation. As discussed above in regard to claim 1, Rassman teaches scheduling components for cases in room 1. *See* FF 6 and 10. After Rassman has scheduled the resources for the cases assigned to room 1, the resources not scheduled for use in room 1 could be considered the "remaining resources." They remain after some of the resources are already scheduled. Some of these resources, for example, will be scheduled, as discussed above with regards to claim 1, for use in *Case klm* and some for use later in *Case mno* in room 3. The resources for *Case klm*, such as the surgeon, can be considered the claimed primary components. They have to be installed in room 3 before the procedure for *Case klm* can be performed and completed. Since *Case mno* is scheduled after *case klm* (FF 10), the resources for Case mno have to be installed after the completion of *Case klm* and in order for *Case mno* to be performed. Therefore, we find that Rassman teaches this limitation.

Accordingly, we find that the Appellants have not overcome the prima facie showing of obviousness, and we sustain the rejection of claim 19 under 35 U.S.C. §103(a) as unpatentable over Rassman and Turnbull.

NEW GROUNDS OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b) (2009), we enter a new ground of rejection on claims 7-12. Claims 7-12 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 7 as representative, claim 7 recites "[a] computer program embodied on a computer readable medium" that includes code segments. We note that the Specification is silent as the meaning of "computer readable medium." Giving claim 7 the broadest reasonable construction, we find that claim 7 encompasses forms of the computer program being embodied on transitory propagating signals *per se*.[2] A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. §101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Accordingly, we reject claims 7-12 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have not overcome the prima facie showing of obviousness as to the rejection of claims 1-19 under 35 U.S.C. § 103(a) as unpatentable over Rassman and Turnbull. We enter a new ground of rejection under 35 U.S.C. §101 on claims 7-12.

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[2] *See* U.S. Patent & Trademark Office, Subject Matter Eligibility of Computer Readable Media, Jan. 26, 2010, available at http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

DECISION

The decision of the Examiner to reject claims 1-19 is affirmed. We enter a new ground of rejection under 35 U.S.C. §101 on claims 7-12.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> • (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> • (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

AFFIRMED; 37 C.F.R. § 41.50(b)

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